

REMARKS

Applicants respectfully submit this Response in reply to the Final Official Action dated January 13, 2011. Applicants believe that this Response is fully responsive to the Final Official Action for at least the reasons set forth herein.

Applicants note that a telephone interview was conducted with the Examiner after Applicants filed a response to the previous Official Action. Applicants' representative discussed the invention and the cited prior art. Applicants representative noted that Wilson was not prior art because the provisional application does not provide a system, method or program that has all of the claimed limitations of the instant application, does not provide an enabling description and does not operate and thus is not entitled to the provisional date for priority. Further to the argument discussed during the interview, Applicants set forth herein greater detail the reasons why Wilson is not prior art, why the provisional application is not enabled and does not describe an operable system.

Claims 9-12 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Wilson et al., U.S. Pat. Pub. 2002/0133387 (hereinafter "Wilson") in view of Huang et al., U.S. Patent No. 6,151,582 (hereinafter "Huang").

Applicants respectfully submit that Wilson is not prior art. Notably, the instant application has a foreign priority date of September 29, 2000. Wilson was filed on June 29, 2001 which is after the instant application's foreign priority date. Applicants representative discuss this issue during a telephone interview with the Examiner. However, it appears that the Examiner did not consider this issue on the record.

Notably, Wilson purportedly claims the benefit of provisional application serial no. 60/214,910. The provisional application was filed on June 29, 2000. A copy of which is attached hereto for the Examiner's convenience. However, Applicants submit that the provisional application does not teach or suggest the claimed invention and even if the reference conceptually teaches an information management system, the provisional application does not have an enabling disclosure. Additionally, the provisional application does not disclose any operable system or method.

A reference provides an enabling disclosure if the reference describes the claimed invention in sufficient detail to enable a person of ordinary skill in the art to carry out the claimed invention. *Impax Labs. Inc., v. Aventis Pharm., Inc.* 468 F.3d 1366, 1383, 81 USPQ2s 1001, 1013 (Fed. Cir. 2006).

Of particular note, while the provisional application purports to disclose methods, systems and computer programs for supply chain management, a reading of the document indicates otherwise; rather than disclosing the systems and methods, the provisional application discloses goals for the systems and concepts. The actual design of the system occurred after the provisional application was filed.

The provisional application consists of a summary, a PowerPoint presentation (the "presentation") and a proposal. The PowerPoint presentation outlines project objectives and goals. In the competitive summary section of the presentation, the slide states "advantages for UPS to prove and **develop**" and "challenges *to overcome*". On the third to last page of the presentation, a generic software architecture is depicted without any detailed solution. Furthermore, the second to last page of the presentation, identifies several different strategies for *obtaining* an IP solution one of which is to *assign a team to evaluate and develop* IT solution.

On the last page of the presentation, the document explicitly states that “**no integrated, scaleable IT solution exists today**” and timing is “*12-18 months*”. Clearly, as of the date of the presentation, no solution had been developed, but rather goals for the solution were identified, concepts were discussed and a plan was discuss to implement a solution.

Moreover, the proposal generically discusses the development of a system (in the future) and discusses functionalities and definitions that should be included in the application.

For example, in the promising functionality section (on page 1), the document states that “it will [sic] important for the application to accept orders for promising from different sources.”

Furthermore, the document indicates that the “promising functionality must be able to promise based again standard lead times or rules” . Later in the same document entitled “Order Promising Business Requirements” explicitly describes the business requirements for the order promising features of the solution.

The only real figure in the document is a generic workflow diagram associated with the overall solution. However, the diagram does not teach the claimed configuration. In fact, once again, the document explicitly notes “that this diagram is a generalized workflow that **does not reflect the design work that will occur as the promising solution is developed.**” (Emphasis added). While Figures can be used for a rejection, if they are sufficiently enabling, the picture must show all of the claimed structural features and how they are put together. The figure in the proposal does not show all of the structural features of the claimed invention and how they are put together.

The remaining portion of the document identifies several functional requirements of the proposed solution (which is to be developed) and promising rules (to be implemented by the future system).

Clearly, when the provisional application was filed, the system(s) were not developed and did not exist. Therefore, the provisional application did not disclose an operable system.

While several functions were conceptually discussed, there is no structure disclosed and no disclosures of how the structure is (are) put together as is required for an enabling disclosure. *See Elan Pharm., Inc., v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003) (merely naming or describing the subject matter is insufficient, if it cannot be produced without undue experimentation). Here, it is clear that the provisional application merely names requirements for a future IT solution to be developed. The document on its face indicates a 12-18 development period. Therefore, a reading of the entire provisional application indicates that no enabling disclosure exists.

Accordingly, while the provisional application was filed prior to the foreign priority date of the instant application, Wilson is not prior art, since the filing date for the provisional application cannot be used in the instant rejection. Since, Huang fails to teach or render obvious all of the limitations of the claims, by itself, Applicants respectfully request that the Examiner withdraw the rejection.

Applicants note that if the Examiner requires a certified translation of the foreign priority document after considering the arguments set forth herein, Applicants will provide the certified translation as indicated in the telephone interview.

Accordingly, Applicants submit that claims 9, 10 and 12 are patentable over the cited references. Therefore, Applicants respectfully request withdrawal of the rejection of claims 9, 10 and 12 pursuant to 35 U.S.C. § 103(a).

Based upon the foregoing, Applicants respectfully submit that the application is in condition for allowance and henceforth solicit a Notice of Allowability. Should the Examiner believe that a telephone interview would expedite allowance of the application; the Examiner is kindly requested to contact the undersigned.

Respectfully submitted,



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